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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,238	04/07/2000	Hideki Nishimoto	0941.63875	2032

24978 7590 10/22/2003

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 10/22/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,238

Applicant(s)

NISHIMOTO ET AL.

Examiner

Jorge L Ortiz-Criado

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A, (Figs. 8, 9A-9D, 4 and 6) in Paper No. 7, filed 9/20/2003 is acknowledged. Claims 9-25 have been canceled.
2. Claims 4 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7, filed 9/20/2003.

Drawings

3. Figures 1, 2, 3, 4, 5A-5C, 6, 7A-7B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "901" and "902" have both been used to designate the grooves in Fig. 9B. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue U.S. Patent No. 5,594,716.

Regarding claim 1, Inoue discloses an optical recording medium comprising:
a substrate having a land and a groove alternately arranged in a predetermined direction (See col. 3, lines 9-22; col. 5, lines 11-20; Fig. 1);
a data recording region provided on the land and the groove (See col. 3, lines 9-22; col. 5, lines 11-20; Fig. 1); and
an identification mark recording region provided on only one of the land and the groove and recorded with a data block identification mark (See col. 3, lines 9-22; col. 5, lines 11-20; Fig. 1).

Regarding claim 2, Inoue discloses wherein the data block identification mark is made of a projecting part formed on the groove and having approximately the same height as the land or, made of a cavity part formed on the land and having approximately the same depth as the groove (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line 16; col. 9, lines 35-43; Fig. 1,4).

Regarding claim 3, Inoue discloses a first identification information recording region recorded with identification information for identifying the data recording region on the land (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line16; col. 9, lines 35-43; Fig. 1,4); and

a second identification information recording region recorded with identification information for identifying the data recording region on the groove (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line16; col. 9, lines 35-43; Fig. 1,4),

said data block identification mark being recorded on only one of the first identification information recording region and the second 5 identification recording region (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line16; col. 9, lines 35-43; Fig. 1,4).

Regarding claim 5, Inoue discloses wherein information for identifying the data recording region is recorded by a magneto-optical recording (See col. 11, lines 8-12; col. 14, lines 62-65).

Regarding claim 6, Inoue discloses wherein a width of the projecting part forming the data block identification mark is greater than or equal to a width of the land (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line16; col. 9, lines 35-43, col. 11, lines 37-57; Fig. 1), and

a width of the cavity part forming the data block identification mark is greater than or equal to a width of the groove (See col. 3, lines 9-22; col. 5, lines 11-40; col. 8, line 64 to col. 9, line16; col. 9, lines 35-43; col. 11, lines 37-57; Fig. 1).

Regarding claim 7, Inoue discloses wherein a depth of the groove forming the data recording region is different from a height of the projecting part and a depth of the cavity part which form the data block identification mark (See col. 8, line 64 to col. 9 line16; Fig. 4).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 6,118,752 to Miyagawa et al., which discloses an optical recording medium including grooves and lands tracks and a data block identification mark which is greater than or equal to the width of the tracks.

b. U.S. Patent No. U.S. Patent No. 6,256,266 to Mitani, which discloses a magneto-optical recording medium having grooves and lands tracks with projecting parts and cavity parts.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm), Alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H To can be reached on (703) 305-4827. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

joc


DORIS H. TO 10/17/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800